



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/803,208

03/09/2001

Toshiyuki Moritsu

10721-9US

8571

24956 7590 03/21/2007
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

03/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/803,208

Applicant(s)

MORITSU ET AL.

Examiner

Dan Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-16,18-22 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-16,18-22 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment filed December 18, 2006 has been entered and fully considered. Claims 1, 2, 7-16, 18-22, 33-36 are currently pending. The rejections are as stated below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2006 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3691

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 2, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al., U.S. Patent No. 6,317,745, in view of Kahn et al., U.S. Patent No. 6,401,079.

Claims 1, 2, 7, Thomas discloses a trusted third party data structure for electronic funds transfer, comprising:

sending electronic data relating to payment intention from a payment mediation system to a receiver system belonging to a receiver when said payment mediation system receives electronic data relating to said payment intention from a payor system belonging to a payor or the payment (column 4 lines 28-32, column 10 lines 10-22, 47-55); and,

requesting a deposit of funds from assets held by said payor into a deposit account of a financial system managed or owned by a financial institution determined from said electronic data relating to said payment intention, said deposit account being identified by the receiver system and provided to the payment mediation system upon

Art Unit: 3691

receipt of the payment intention from the payment mediation system, and said payment mediation system requesting the deposit of funds into said deposit account when said payment mediation system receives electronic data relating to said deposit account from the receiver system (column 4 lines 44-52).

Thomas fails to teach the payment information including a payment due date or payment period.

Kahn teaches a system and method for administering reoccurring transactions, such as payroll and benefits, including a payroll date (column 18 lines 30-50). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Thomas to include the payroll date identification of Kahn because Thomas teaches a payor initiated payment system and method, and the payments taught by Kahn are employer/employee payroll payments, and it is desirable that payroll payments need not be initiated by the employee, but rather are reoccurring and initiated by the employer.

Thomas and Kahn fail to teach the payor being a social insurance agency and the receiver being a beneficiary. This recitation is regarded as intended use, and does not distinguish the invention over the prior art. Applicant's specification suggests that the system can be applied to social insurance payments between agency and beneficiary or payroll payments between employer and employee, as examples. The teachings of Thomas can be applied to any electronic funds transfer between a payor

Art Unit: 3691

and a payee. Since the intended use of Applicant's invention, as claimed, does not change the functionality of the system or method, and the prior art would be capable of operating in the environment of Applicant's invention, the intended use limitations are not considered limiting.

Claims 8, 9, Thomas teaches receiving electronic data relating to the deposit account identification, and sending electronic data used to check for the existence of a recipient account (routing and transit numbers) to the financial system (column 6 lines 7-22). While Thomas does not explicitly teach verifying the existence of a deposit account, and receiving data indicating the existence of a deposit account, these steps are inherent when the trusted third party uses the account data to make a deposit.

Claim 10, Thomas teaches the payment intention data includes a payment amount (column 4 lines 28-32).

6. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas and Kahn.

Thomas and Kahn fail to teach the use of user IDs and passwords for use by senders and recipients of funds in the system. In a previous Office Action, Examiner took Official Notice of this feature, noting that the feature was old and well known in the art. Since Applicant did not adequately traverse Examiner's Official Notice, the common knowledge or well known in the art statement is taken to be admitted prior art. See

Art Unit: 3691

MPEP 2144.03(C). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Thomas and Kahn to include requiring user IDs and passwords from a payer, when establishing a payment intention, and from a payee when receiving the electronic funds, because the increased security provided by these features is desirable in any financial environment.

7. Claims 11-16 are rejected under U.S.C. 103(a) as being unpatentable over Thomas and Kahn, as applied above, and further in view of Smorodinsky, U.S. Patent No. 6,049,786.

Thomas fails to teach the use of hash values in the encryption of digitally signed transmissions, storing transactions, along with their hash values, in a database, deciphering incoming transmissions, and verifying their authenticity by comparing extracted hash values with known values from the database. Smorodinsky discloses an electronic bill payment system employing hashes and digital signatures, a biller computer having a database which stores a plurality of complete bills and a respective hash which is digitally signed, decrypting digitally signed hashes and comparing them with new hashes to determine whether or not the transmission is authentic (column 2 lines 40-67). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Thomas and Kahn to include the hash and digital signature features of Smorodinsky because the specific implementation of Smorodinsky would provide increased security, which is a desired characteristic of any electronic payment transaction.

8. Claims 18, 20-22, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas and Kahn, as applied above, and further in view of Chang, U.S. Patent No. 5,884,288.

Claims 18, 20, 21, Thomas and Kahn fail to teach registering the deposit account and information indicating that funds are unpaid in the payment status field, searching the database for a deposit account associated with the payment status indicating funds are unpaid, changing the payment status to paid when funds have been transferred, and changing the payment status to past due when no payment is received by a due date.

The Chang reference has been fully discussed in the previous Office Action, however the relevant citations for the current rejections are repeated below.

Claims 18, 20, and 21, Chang teaches the intermediary sends notification of the pending payment instruction data to the payee (column 7 lines 25-30). Furthermore, Chang inherently teaches the system changes the status to paid when transactions have been completed (column 6 lines 56-61). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Thomas and Kahn to include the billing related features as taught by Chang because Thomas and Kahn teach the funds transfer system being used to pay bills, which inherently have due dates.

Claim 22, the combination of Thomas, Kahn, and Chang fail to teach changing the payment status to past due when no payment has been made within the payment period or by the payment due date. In a previous Office Action, Examiner took Official Notice of this feature, noting that the feature was old and well known in the art. Since Applicant did not adequately traverse Examiner's Official Notice, the common knowledge or well known in the art statement is taken to be admitted prior art. See MPEP 2144.03(C). Thus, it would be obvious to modify the teachings of Thomas, Kahn, and Chang to include this step because it is vital to a financial obligation that both the payor and payee of a transaction be aware of past due obligations.

Claims 34, 36, Chang teaches viewing outstanding bills and due dates, and authorizing future payment of specified bills (column 8 lines 39-51). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Thomas and Kahn to include the scheduling of future payments because it provides a user with additional convenience and ease of use, which are desirable features of electronic payment systems.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, Kahn and Chang, in view of Yu et al., U.S. Patent No. 6,067,621.

Claim 19, the combination of Thomas, Kahn and Chang fails to teach transmitting data to an IC card for authentication, and deleting the data before the IC card is removed. Yu discloses a user authentication system for authenticating an authorized

user of an IC card, for the purpose of a secure financial transaction, transmitting an access key to the IC card for user authentication, and deleting the information before the card is removed (column 9 lines 35-53). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Chang to include Yu's teachings of user authentication using an IC card because Chang teaches that the electronic transactions that are transmitted utilize a digital signal and certification protocol, and any of the well known digital signature and certification protocols can be used (column 7 lines 63-66).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HANI M. KAZIMI
PRIMARY EXAMINER